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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ULRICH ORTH, STEFFEN TECKENTRUP, VOLKER
WEDLER, and ULF WILLERS

Appeal 2008-5132
Application 10/804,089
Technology Center 3700

Decided: December 5, 2008

Before ERIC GRIMES, RICHARD M. LEBOVITZ, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a database of dental data. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Statement of the Case

Background

“[T]ooth models exist as individual models for each position in the jaw. These are intended in the widest sense for visual instruction purposes and to help answer questions on dentistry in a plastic and practical manner” (Spec. 1). The Specification notes that “libraries of teeth and respective data have been known for many years, these objects being both in the form of physical models and in digitized form” (*id.*). According to the Specification “[t]he drawback of such tooth libraries is that they contain no tooth or dentition data of a large number of real persons” (*id.* at 2).

The Claims

Claims 1-18 and 26 are on appeal. We will focus on claim 1, which is representative and reads as follows:

1. A data base for the storage of data, said data base comprising dental data concerning universally applicable dentition-specific features and universally applicable tooth-specific features, wherein the dental data illustrate real teeth as images in digitized form and said digitized form also involves one of universally applicable dentition-specific features, tooth-specific features and structural properties, including at least one of sex-specific, tooth family-specific, biography-specific, and person-specific characteristics, with or without anomalous characteristics.

The prior art

The Examiner relies on the following prior art references to show unpatentability:

Paiz	US 2001/0037304 A1	Nov. 1, 2001
Farag et al.	US 2002/0028418 A1	Mar. 7, 2002

The issues

A. The Examiner rejected claims 1-14, 17, 18, and 26 under 35 U.S.C. § 102(b) as being anticipated by Farag (Ans. 3).

B. The Examiner rejected claims 15 and 16 under 35 U.S.C. § 103(a) as being obvious over Farag and Paiz (Ans. 3).

A. 35 U.S.C. § 102(b) over Farag

The Examiner finds that “Farag discloses the use of a database for the storage of dental data (paragraph 0038), said dental data being 3-D images of a patient's oral cavity in digitized form” (Ans. 3). The Examiner finds that the “stored 3-D image comprises universally applicable dentition-specific and tooth-specific features, such as tooth family-specific features (for example, image 123 in Figure 8 is a representative 3-D image of a patient's dentition that shows the location and shape of various teeth).” (*Id.*)

The Examiner contends that “[a]lthough Appellant admits that the 3-D image stored in the database of Farag does show specific features, ‘such features are not identified separately’ (page 7, Appeal Brief). Again, Examiner contends that such a limitation is not claimed” (*id.* at 7).

Appellants “respectfully assert[] that for *Farag*, the storage of a 3-D image (275/285) in association with patient information is merely of an administrative nature and leads to an electronic file” (App. Br. 6).

Appellants contend that “[w]hile the *Farag* 3-D image (275/285) does show specific features, such features are not identified separately in the image and cannot be used as characteristics for any search in the database” (*id.* at 7).

Appellants contend that “contrary to the express recitation in independent claim 1 of the present invention, *Farag* does not disclose a

database with identified tooth-specific structures, but only discloses storage of 3-D images” (*id.*).

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Have Appellants shown that the Examiner erred in finding that Farag teaches a database which satisfies the limitations of claim 1?

Findings of Fact (FF)

1. The Specification states that “‘tooth data bank’ will be used to designate a data base/library which contains a number of digitized tooth shapes of real teeth including information on the owner of each tooth and/or structural elements of the tooth” (Spec. 3).
2. Farag teaches that “[m]ethod **300** includes receiving **310** a plurality of two-dimensional (2-D) images of an oral cavity” (Farag 4 ¶ 0035).
3. Farag teaches that “method **300** includes generating **320** at least one three-dimensional (3-D) image of the oral cavity from the plurality of 2-D images (Farag 4 ¶ 0036).
4. Farag teaches that “method **300** includes storing **340** the 3-D image in association with patient information. For example, the 3-D image is stored in a database of patient records” (Farag 4 ¶ 0038).
5. Farag teaches that “[o]ptionally, method **300** further includes modifying **350** the 3-D image in accordance with a proposed or suggested orthodontic or dental treatment of the patient” (Farag 4 ¶ 0039).

Principles of Law

“To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

Analysis

Farag teaches a database for storage of dental data (FF 4). Farag teaches that this data is generated from the oral cavity of actual patients with “real teeth” (FF 2-3). Farag teaches that the digitized data has individual specific information which may be manipulated for orthodontic or dental treatment of an individual patient (FF 5).

We find that Farag teaches a database of dental data which includes digitized images of real teeth that have “person-specific characteristics.” Farag has satisfied each limitation of claim 1.

We are not persuaded by Appellants’ argument that “for *Farag*, the storage of a 3-D image (275/285) in association with patient information is merely of an administrative nature and leads to an electronic file” (App. Br. 6). Claim 1 does not distinguish between “person-specific characteristics” which are “administrative” and characteristics which have some other requirement. The data of Farag satisfies the claim as written, and the Specification does not provide any further limiting definition which distinguishes the claimed data base from the patient identification and dental record information of Farag.

We also do not find persuasive Appellants’ argument that “[w]hile the *Farag* 3-D image (275/285) does show specific features, such features are

not identified separately in the image and cannot be used as characteristics for any search in the database” (App. Br. 7). There is no limitation in claim 1 which requires that the data be capable of being separately searched. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (*citing In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)) (“Moreover, limitations are not to be read into the claims from the specification.”)

We are not persuaded by Appellants’ argument that “*Farag* does not disclose a database with identified tooth-specific features, but only discloses storage of 3-D images” (Reply Br. 8). We agree with the Examiner that “the 3-D image of the patient's oral cavity stored in the database of *Farag* includes these characteristics - for example, an examination of said image would yield tooth family-specific characteristics (such as the shape and location of each molar, cuspid, incisor, etc.)” (Ans. 8.) The 3-D image itself contains tooth-specific features that are unique to the patient under examination (FF 2-3). Those features are clearly tooth-specific and satisfy the requirements of claim 1.

Conclusions of Law

Appellants failed to show that the Examiner erred in finding that *Farag* teaches a database which satisfies the limitations of claim 1.

B. 35 U.S.C. § 103(a) over Farag and Paiz

We have already concluded that Farag teaches the limitations of claim 1. Appellants do not separately argue that the limitations of claims 15 and 16 are not taught by the combination of Farag and Paiz, but rely upon the same arguments for the anticipation rejection over Farag. Therefore, we affirm the rejection of claims 15 and 16 over Farag and Paiz.

SUMMARY

In summary, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b) over Farag. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejections of claims 2-14, 17, 18, and 26 as these claims were not argued separately. We also affirm the rejection of claims 15 and 16 under 35 U.S.C. § 103(a) over Farag and Paiz.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

cdc

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